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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,812

02/05/2004

David E. Miller

30781/39842

5964

4743

7590

06/22/2007

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EXAMINER

CHEUNG, VICTOR

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

06/22/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/772,812

Applicant(s)

MILLER, DAVID E.

Examiner

Victor Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/30/2004, 09/29/2005</u>                                    | 6) <input type="checkbox"/> Other: ____                           |

## DETAILED ACTION

### *Specification*

1. The numbering “[0028]” should be removed from the abstract.

### *Claim Objections*

2. Claims 7, 14, 20, 22, and 23 are objected to because of the following informalities:

Re Claim 7: “wherein the computing device is selected from the group of computing devices consisting of CD players, DVD players, desktop computers, laptop computers, personal digital assistants, wireless PC tablets, and cellular phones” should be –wherein the computing device is selected from the group consisting of a CD player, a DVD player, a desktop computer, a laptop computer, a personal digital assistant, a wireless PC tablet, and a cellular phone--.

Re Claim 14, Lines 3-4: “the activating step” should be –the positively actuating step--.

Re Claim 20: “wherein the displaying step involves using a computing device selected from the group of computing devices consisting of DVD players, CD players, desktop computers, laptop computers, personal digital assistants, wireless PC tablets, and cellular phones” should be changed to –wherein the computing device is selected from the group consisting of a DVD player, a CD player, a desktop computer, a laptop computer, a personal digital assistant, a wireless PC tablet, and a cellular phone--.

Re Claim 22, Line 8: “a signal emitted by the transmitter” should be –the signal emitted by the transmitter--.

Re Claim 23, Lines 2-3: "the actuator is selected from the group of actuators consisting of pressure-sensitive actuators, heat-sensitive actuators, touch-sensitive actuators, voice-sensitive actuators and electrical contact actuators" should be --the actuator is selected from the group consisting of a pressure-sensitive actuator, a heat-sensitive actuator, a touch-sensitive actuator, a voice-sensitive actuator, and an electrical contact actuator--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5-6 and 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re Claim 5: Claim 5 recites the limitation "the plurality of actuators extending into the plurality of pages" in lines 2-3. It is unclear what the phrase "extending into" means. For the remainder of this office action, the limitation is read as --the plurality of actuators embedded in the plurality of pages-- as per dependent claim 6.

Re Claim 6: Claim 6 is rejected as being dependent on claim 5.

Re Claim 13: Claim 13 recites the limitation "the book" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is suggested that "the book" be changed to --the plurality of pages--.

Re Claims 14-17: Claim 14 recites the limitation “a hand-held book” in line 2, while Claims 15-17 each recite the limitation “the book” in lines 3, 2, and 2, respectively. There is insufficient antecedent basis for “the book” in claims 15-17. If “hand-held book” and “book” refer to the same object, the terminology used should be the same.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 5-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Rathus et al. (US Patent No. 6,164,534).

Re Claim 1: Rathus et al. disclose a learning device comprising a plurality of pages (Fig. 1), a transmitter operatively associated with the plurality of pages, the transmitter transmitting a signal when positively actuated by a user (Fig. 2, Ref. No. 23; Col. 5, Lines 40-42), a computing device (Fig. 2, Ref. No. 25; Col. 5, Lines 43-48), and a receiver operatively associated with the computing device, the receiver receiving the signal from the transmitter (Fig. 2, Ref. No. 26), the computing device adapted to display electronic media based on the signal received from the transmitter (Col. 5, Lines 40-48).

Re Claim 2: Rathus et al. disclose the plurality of pages bound together by a binding, the transmitter embedded in the binding (Fig. 1, Ref. No. 4; Col. 5, Lines 18-23, 29-35).

Re Claim 3: Rathus et al. disclose the transmitter embedded in one of the pages (Col. 5, Lines 21-23).

Re Claims 5 and 6: Rathus et al. disclose the transmitter operatively associated with a plurality of actuators, the plurality of actuators embedded in the plurality of pages (Col. 8, Lines 38-42).

Re Claim 7: Rathus et al. disclose the computing device selected from the group consisting of a CD player, a DVD player, a desktop computer, a laptop computer, a personal digital assistant, a wireless PC tablet, and a cellular phone (Col. 5, Lines 45-48).

Re Claim 8: Rathus et al. disclose that the computing device is web enabled (Claim 32, Col. 12, Lines 20-21).

Re Claims 9 and 10: Rathus et al. disclose transmitting and receiving over a wired or wireless connection (Col. 5, Lines 31-35).

Re Claim 11: Rathus et al. disclose that the transmitter is an optical scanner (Figs. 4, 4a; Col. 6, Lines 6-20) with wireless transmission capability (Figs. 4, 4a; Col. 6, Lines 35-38). Note that while Rathus et al. do not specifically disclose that the scanning is performed optically, it is inherent of the invention that the transmitter include an optical scanner when the scanned feature is a bar code, printed character, symbol, picture, etc., as disclosed in Rathus et al.

Re Claims 12 and 13: Rathus et al. disclose each actuator disposed proximate to a margin note or proximate to text within the plurality of pages (Col. 8, Line 41).

Re Claim 14: Rathus et al. disclose a method for learning including reading text provided within a book (Col. 4, Lines 15-16, 20), positively actuating a transmitter provided within the hand-held book, the actuating step transmitting a signal (Col. 5, Line 40), receiving the signal in a

computing device (Col. 5, Lines 42-43), and displaying electronic media on the computing device based on the received signal (Col. 5, Lines 43-45).

Re Claim 15: Rathus et al. disclose that positively actuating involves depressing an actuator operatively associated with the transmitter and provided within the hand-held book (Col. 3, Lines 3-5).

Re Claims 16 and 17: Rathus et al. disclose the actuator embedded in a page or a binding of the hand-held book (Col. 8, Lines 38-42).

Re Claims 18 and 19: Rathus et al. disclose transmitting and receiving over a wired or wireless connection (Col. 5, Lines 31-35).

Re Claim 20: Rathus et al. disclose the computing device selected from the group consisting of a CD player, a DVD player, a desktop computer, a laptop computer, a personal digital assistant, a wireless PC tablet, and a cellular phone (Col. 5, Lines 45-48).

Re Claim 21: Although Rathus et al. do not specifically disclose repeating the positively actuating step, it is inherent in the invention that the method be repeatable. Because the invention of Rathus et al. include a plurality of actuators, it is an inherent aspect of the invention that a plurality of actuators be actuated, whether the actuating steps are performed in succession or over a specific period of time.

Re Claim 22: Rathus et al. disclose a learning device comprising a plurality of pages (Fig. 1), a binding connecting the plurality of pages, a transmitter mounted in one of the plurality of pages and the binding (Fig. 1, Ref. No. 4; Col. 5, Lines 18-23, 29-35), the transmitter being adapted to transmit a signal when positively actuated by a user (Fig. 2, Ref. No. 23; Col. 5, Lines 40-42), an actuator mounted in at least one page and connected to the transmitter (Fig. 2; Col. 8, Lines 38-42), and an

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electronic storage device adapted to be loaded into a computing device having a receiver adapted to receive the signal emitted by the transmitter (Col. 5, Lines 43-56).

Re Claim 23: Rathus et al. disclose the actuator selected from the group consisting of a pressure-sensitive actuator, a heat-sensitive actuator, a touch-sensitive actuator, a voice-sensitive actuator, and an electrical contact actuator (Col. 5, Line 27).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rathus et al. (US Patent No. 6,164,534) as applied to claim 1 above, and further in view of Leung (US Patent No. 5,569,868).

Rathus et al. disclose the limitations of claim 1 above.

However, Rathus et al. do not disclose more than one transmitter operatively associated with the plurality of pages.

Leung teaches a sound generating book including a plurality of sensors, the plurality of sensors including transmitters and receivers (Col. 1, Lines 57-59)



Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to include more than one transmitter operatively associated with the plurality of pages, thereby providing each sensor in the plurality of pages a dedicated transmitter to sense actuation of the sensor, preventing inadvertent actuation of triggers of alternate pages.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- Redford et al. (US Patent No. 5,624,265) disclose a printed publication remote control for accessing interactive media, including a printed publication, buttons and sensors for user-actuation, a transmitter for wirelessly communicating with a multimedia host device to display media related to the printed publication content.
- Pierce et al. (US Patent No. 5,356,296) disclose an audio storybook including a plurality of sensors embedded in to the pages of the storybook.
- Fernandez (US Patent No. 4,855,725) disclose a simulated book including infrared transmitters for communicating with a computer for retrieving content.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Cheung whose telephone number is (571) 270-1349. The examiner can normally be reached on Mon-Thurs, 8-4:30, and every other Fri, 8-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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June 18, 2007

  
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Art Unit 3714